

**REMARKS****A. Claim to Priority**

The Office Action acknowledges a claim to priority was made by Applicant based on an application filed in France on December 5, 2002. However, the Office Action indicates that a certified copy of the French application pursuant to 35 U.S.C. §119(b) was not received.

In response, Applicant notes that a certified copy of the foreign priority document was filed on December 4, 2003 with the Claim to Convention Priority. Furthermore, Applicant has received a stamped postcard from the USPTO indicating that the priority document was received (see attached copy of the stamped postcard). Nevertheless, Applicant submits (for the second time) a certified copy of the corresponding French application in order to comply with the requirements of 35 U.S.C. §119(b).

**B. Status of the Claims and Explanation of the Amendments**

Prior to the submission of this paper, claims 1-10 were pending. In this paper, Applicant has rewritten claim 1 to incorporate the elements of claim 3, and has cancelled claim 3. Claims 2, 4, and 6-9 have been amended to remove the phrase "the said", thereby placing them in better conformance with US. patent practice. Currently, claims 1, 2, and 4-10 are pending and presented for examination.

Claims 1, 2, 4-6, and 10 have been rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Applicant's alleged "admissions", in view of US. Patent No. 5,614,338 to Pyburn et al. ("Pyburn"). Claims 1-3, 5-8, and 10 have been rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Applicant's alleged "admissions" in view of JP 2000-176659 to Hideji ("Hideji"). Claim 9 has been rejected under 35 U.S.C. § 103(a) over

Applicant's alleged "admissions" and Hideji, in view of U.S. Patent No. 5,149,589 to Naritomi ("Naritomi").

C. Applicant's Claims Are Not Unpatentable

Applicant respectfully traverses the above-mentioned rejections of Applicant's claims under 35 U.S.C. §103(a), for several reasons: (1) the combination of Applicant's alleged "admissions" and Pyburn fails to teach, disclose, or suggest all of the claim elements of Applicant's invention; (*see* MPEP §2144.03) (2) there is no proper motivation to combine Applicant's alleged "admissions" and Hideji; (*see* MPEP § 2143.01) and (3) there is no proper motivation to combine Applicant's alleged "admissions" with Hideji and Naritomi (*see* MPEP §2143.01).

Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejection of Applicant's claims under 35 U.S.C. §103(a).

1. Claims 1, 2, 4-6 and 10 Are Not Unpatentable  
Over the Alleged "Admissions" and Pyburn

Applicant respectfully traverses the rejection of claims 1, 2, 4-6 and 10 as allegedly being unpatentable over Applicant's alleged "admissions" in view of Pyburn. Without conceding that Applicant has "admitted" the subject matter alleged by the Office Action, Applicant notes that the combination of the alleged "admissions" and Pyburn fails to teach, disclose, or suggest all of the claim elements of Applicant's invention. Accordingly, the rejection of claims 1,2,4-6 and 10 should be withdrawn. MPEP §2143.01.

Pyburn is directed to manufacturing backlit displays utilizing treated plastics and laser energy. Importantly, Pyburn's process uses a laser to provide an opaque region that ultimately provides contrast for Pyburn's buttons. For example, Pyburn explicitly specifies that

the invention generally involves forming a backlit button from a substantially transparent polymeric material in which pigmentation is present. According to the invention, the pigmentation is selected to be of a type that is reactive to laser energy, meaning that the pigment particles dispersed in the polymeric material have a high absorption coefficient to the wavelength of a particular laser light. When exposed to the light energy, localized overheating occurs around the pigment particles, darkening the transparent polymeric material immediately surrounding the pigment particles so as to create a contrasting graphic image in the polymeric material.. As a result, exposed portions of the button become substantially opaque while remaining portions of the button remain substantially transparent. [Pyburn, col. 2, line 46 to col. 3, line 1, emphasis added].

Unlike Pyburn's laser, which merely makes regions with pigmentation become *opaque*, the laser in Applicant's process is used to make regions that formerly were covered by metal become *transparent* to allow the passage of light. This is seen, for example, in Applicant's amended claim 1, in which a laser is used to selectively remove the surface metallization on a component of a lighting or indicating apparatus for a motor vehicle.

Applicant's amended claim 1 reads as follows:

1. A method of forming a decorative motif on a component of a lighting or indicating apparatus for a motor vehicle, including  
a step of forming said component in a predetermined material,  
a step of completely metallising said component, and  
a step of exposing at least one surface of said metallised component to laser radiation, to selectively remove, by laser radiation, the metal on at least one surface of said metallised component.

Nowhere does Pyburn teach, disclose, or suggest “[a] method of forming a decorative motif.. including...a step of completely metallising [a] component. ..and a step of exposing at least one surface of said metallised component to laser radiation, to selectively remove, by laser radiation, the metal on at least one surface of said metallised component.” For that matter, neither do Applicant's “alleged admissions,” as stated by the Office Action.

Accordingly, because combination of references fails to teach, disclose, or suggest all of the claim elements, the rejection of Applicant's claims 1,2,4-6 and 10 under 35 U.S.C. §103(a) as allegedly being unpatentable over Pyburn should be withdrawn.

Reconsideration and withdrawal of the rejection of claims 1, 2, 4-6 and 10 are respectfully requested.

2.     There is No Proper Motivation to Combine  
          the Alleged Admissions and Hideji

Applicant respectfully traverses the rejection of claims 1-3, 5-8, and 10 under 35 U.S.C. §103(a) as being allegedly unpatentable over Applicant's alleged "admissions", in view of Hideji. Briefly, the Office Action has not established a proper motivation to combine Applicant's alleged "admissions" and Hideji, which belong to separate, non-analogous fields of technology. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejection of these claims. MPEP §§ 2141.01(a) and 2143.01.

With respect to Hideji, Applicant notes that although Hideji is entitled "Method for Processing Character, Numeral, Mark or Pattern or the Like on Transparent Material", the abstract of Hideji (upon which the Office Action relies) only discusses Hideji's manufacturing method as applied to the manufacture of a *portable telephone set*. Nowhere in the abstract does Hideji appear to teach, disclose, or suggest that Hideji's process is suitable for an automobile indicating or lighting apparatus.

According to the Office Action, Applicant's so-called "admissions" only relate to motor manufacturer's need for particular motifs or patterns on lighting and indicating devices. The Office Action fails to show any teaching, express or otherwise, that manufacturing

processes that are used in the portable telephone industry (e.g., that of Hideji's) are suitable for the needs of motor manufacturers.

At best, the Office Action merely states that the motivation for the combination of Applicant's prior art with Hideji "would have been to obtain the desired aesthetic effect." [Office Action, page 5, line 3]. However, nowhere does the Office Action provide any motivation for one of ordinary skill in the art in motor manufacturing to look, *in the first place*, to the portable telephone art for manufacturing processes. Accordingly, Applicants maintain that the Office Action has failed to provide a proper motivation for the combination of the references. Absent any proper motivation for the combination, the combination appears to rely on impermissible hindsight (*see* MPEP §2145, Subsection X, Part A).

3. Claim 9 is not Unpatentable Over the Cited References

In the rejection of claim 9, the Office Action relies on Applicant's alleged "admissions" and Hideji for all aspects of claim 9, except for a thermoplastic article, for which relies on Naritomi. However, as noted above in the immediately preceding subsection, there is no proper motivation to combine Applicant's alleged "admissions" with Hideji. Applicant, upon review of Naritomi, also does not see where Naritomi alleviates the deficiency of the Office Action's proposed combination of Applicant's alleged "admissions" and Hideji.

Accordingly, Applicant maintains that the rejection of claim 9 under 35 U.S.C. §103(a) is improper and should be withdrawn.

**CONCLUSION**

Based on the foregoing amendments and remarks, Applicants respectfully request reconsideration and withdrawal of the rejection of claims and allowance of this application.

**AUTHORIZATION**

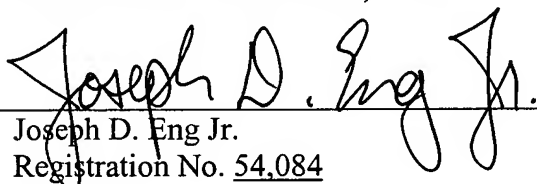
The Commissioner is hereby authorized to charge any additional fees which may be required for consideration of this Amendment to Deposit Account No. 13-4500, Order No. 1948-4825. A DUPLICATE OF THIS DOCUMENT IS ATTACHED.

In the event that an extension of time is required, or which may be required in addition to that requested in a petition for an extension of time, the Commissioner is requested to grant a petition for that extension of time which is required to make this response timely and is hereby authorized to charge any fee for such an extension of time or credit any overpayment for an extension of time to Deposit Account No. 13-4500, Order No. 1948-4825. A DUPLICATE OF THIS DOCUMENT IS ATTACHED.

Respectfully submitted,  
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Dated: June 15, 2005

By: \_\_\_\_\_

  
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